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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/783,072

02/20/2004

Maki Kawasaki

600630-17US (563114)

6281

570

7590

07/02/2007

AKIN GUMP STRAUSS HAUER & FELD L.L.P.

ONE COMMERCE SQUARE

2005 MARKET STREET, SUITE 2200

PHILADELPHIA, PA 19103

EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT

PAPER NUMBER

1713

MAIL DATE

DELIVERY MODE

07/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/783,072	<b>Applicant(s)</b> KAWASAKI ET AL.	
	<b>Examiner</b> Dr. Kelechi C. Egwim	<b>Art Unit</b> 1713	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1 &amp; 081904</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims directed to the following patentably distinct species of the following two genii:

#### Genus I

- a. wherein the film is polyethylene (claim 2)
- b. wherein the film is ethylene-vinyl acetate copolymer (claim 3)
- c. wherein the film is ethylene-methyl methacrylate copolymer (claim 4)

#### Genus II

- a. wherein the fabric protectant ester compound is 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(1-propenyl)-2,2-dimethylcyclopropanecarboxylate. (claim 6)
- b. wherein fabric protectant ester compound is 2,3,5,6-tetrafluorobenzyl 3-(2,2-dichlorovinyl)-2,2-dimethylcyclopropanecarboxylate. (claim 7)

The species are independent or distinct because they are not art recognized equivalents.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for each genus for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

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readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

2. During a telephone conversation with Bill Schwarze on 6/20, a provisional election was made without traverse to prosecute the invention of species Ia and IIa, claims 1, 2, 5 and 6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 4 and 7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugano (EP 962140).

In ¶'s 6 and 25, Sugano teaches a fabric protectant which is a pyrethroid consistent with formula (1) in the present claims with a compound such as 2,4,6-triisopropyl-1,3,5-trioxane, the fabric protectant being contained in a container such as polyethylene film.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

It is noted that, although the claims recite that the fabric protectant is enveloped in a film, the current claims are not to the film, but to the fabric protectant **itself**.

6. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Aoki et al. (JP 2000355510).

In the abstract, Aoki et al. teach a fabric protectant which is a pyrethroid ester compound exemplified by 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(2,2-dichlorovinyl)-2,2-dimethyl-cyclopropanecarboxylate, with a carrier such as trioxane.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

7. Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by Tsushima (US 2005/0137250).

In ¶ 5, Tsushima teaches a fabric protectant comprising an ester pyrethroid compound exemplified by 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(1-propenyl)-2,2-dimethyl-cyclopropanecarboxylate with 2,4,6-triisopropyl-1,3,5-trioxane.

Thus, the requirements for rejection under 35 U.S.C. 102(a) are met.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugano combination with Tsushima or Takagawa et al. (JP 2002320544).

Sugano, above, differs from the claimed invention in that they do not exemplify 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(1-propenyl)-2,2-dimethyl-cyclopropanecarboxylate as the pyrethroid ester compound. However, it is also known in the art to use 2,3,5,6-

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tetrafluoro-4-methylbenzyl 3-(1-propenyl)-2,2-dimethyl-cyclopropanecarboxylate as a species of the genus pyrethroid ester fabric protectant in insecticide formulations, such as taught by Tsushima, above, or Takagawa et al.

In the abstract, Takagawa et al. teaches a mothproof cover comprising 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(1-propenyl)-2,2-dimethyl-cyclopropanecarboxylate as a fabric protectant insecticide compound.

As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(1-propenyl)-2,2-dimethyl-cyclopropanecarboxylate as the pyrethroid ester compound in the fabric protectant of Sugano because 1) Sugano teach a pyrethroid ester compound in their fabric protectant, 2) Tsushima or Takagawa et al. teach 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(1-propenyl)-2,2-dimethyl-cyclopropanecarboxylate as a species of pyrethroid ester and 3) one having ordinary skill in the art, at the time the invention was made, would have been motivated by a reasonable expectation of success to use 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(1-propenyl)-2,2-dimethyl-cyclopropanecarboxylate as the insecticide in the fabric protectant of Sugano.

Further, the species of genus is prima facie obvious. It is applicants burden under these to establish that species or sub-species provides some unexpected results over the applied reference(s). See In re Woodroff, 16 USPQ2d 1934(Fed. Cir. 1990): In re Susi 169 USPQ 423 (CCPA 1971).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**KELECHI C. EGWIM PH.D.**  
**PRIMARY EXAMINER**

KCE

